

Please type a plus sign (+) inside this box → +

PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paper Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/542,367
Filing Date	April 20, 2000 NOV 24 2004
First Named Inventor	MOSKOWITZ, Paul Andrew
Group Art Unit	3621
Examiner Name	Firmin Backer
IBM Docket Number	YOR9-2000-0171

Total Number of Pages in This Submission **26**

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition Under 37 C.F.R. §1.181(a) to Withdraw Holding of Abandonment <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Declaration and Power of Attorney – 8 pages in total <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Copies of Appeal Brief and Notice of Appeal to March 12, 2004 Final Office Action, copy of date-stamped Postcards, and Acknowledgement Postcard
----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------	-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------	-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

RECEIVED

DEC 09 2004

GROUP 3600

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Kurt M. Maschoff
Signature	
Date	November 18, 2004

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450:		November 18, 2004
Type or printed name	Edith Martin	
Signature		Date November 18, 2004

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

Group Art Unit: 3621 NOV 24 2004

Examiner: Firmin Backer **OFFICE OF PETITIONS**

Applicants: MOSKOWITZ et al.

Application Serial No.: 09/542,367

**Petition Under 37 C.F.R. §1.181(a) to
Withdraw Holding of Abandonment**

Filing Date: April 20, 200

IBM Docket No.: YOR9-2000-0171
(Attorney Docket No.: I01.078)

For: SYSTEM AND METHOD FOR A
FEE ADDRESS SYSTEM

Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 18, 2004.

Dated: November 18, 2004

By:

Edith Martin
Edith Martin

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

DEC 09 2004

GROUP 3600

Sir:

A Notice of Abandonment has been received in the above-identified application. The Notice was mailed on November 5, 2004 and indicates that the application has been abandoned for failing to reply to an Office Action mailed on March 12, 2004. Applicants submit that a timely and complete response to the Office Action was transmitted to the office, including; (a) a Notice of Appeal filed on May 4, 2004, and (b) an Appeal Brief filed on August 12, 2004 both

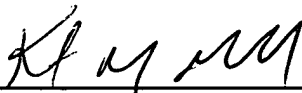
filed under the provisions of 37 C.F.R. §1.8. Accordingly, withdrawal of the holding of abandonment and revival of the application are respectfully requested.

Enclosed are copies of postcard receipts evidencing the deposit of the Appeal Brief under 37 C.F.R. §1.8 on August 12, 2004 and the Notice of Appeal on May 4, 2004. The postcard receipts bears a PTO mailroom stamp indicating receipt of the Appeal Brief by the PTO on August 18, 2004 and the Notice of Appeal on May 6, 2004. To complete the PTO filewrapper, a copy of the Appeal Brief and the Notice of Appeal are enclosed. It is noted that the copy of the Appeal Brief bears a Certificate of Mailing under 37 C.F.R. §1.8 that also evidences the deposit of the response on August 12, 2004. It is further noted that the Notice of Appeal bears a Certificate of Mailing under 37 C.F.R. §1.8 that also evidences the deposit of the Notice of Appeal on May 4, 2004.

Please contact the undersigned for any clarification or further information required in support of this Petition.

Respectfully submitted,

November 18, 2004
Date



Kurt M. Maschoff
Registration No. 38,235
Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840
(203) 972-0081



Date: 05/14/2004
37 C.F.R. § 1.8

Title: **SYSTEM AND METHOD FOR A FEE ADDRESS SYSTEM**

Inventor(s) Moskowitz et al.

Enclosed herewith are:

- ☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences.
- ☒ Transmittal Letter.

Atty. Docket No.: YOR9-2000-0171
Serial No.: 09/542,367
Filing Date: 04/04/2000

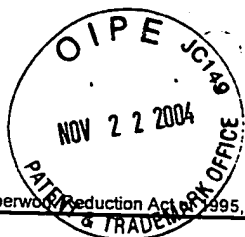


101.078

RECEIVED MAY 11 2004

RECEIVED
NOV 24 2004
OFFICE OF PETITIONS

RECEIVED
DEC 09 2004
GROUP 3600



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Docket Number (Optional)

IBM Docket No.: YOR9-2000-0177
Attorney Docket No.: 101.078

RECEIVED

NOV 24 2004

OFFICE OF PETITIONS

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on May 4, 2004

Signature

Edith Martin

Typed or printed name Edith Martin

In re Application of
MOSKOWITZ ET AL.

Application Number
09/542,367

Filed
April 4, 2000

For System and Method for a Fee Address System

Art Unit
3621

Examiner
Backer, Firmin

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 1.17(b))

\$ 330.00

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:

\$ _____

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 50-0510. I have enclosed a duplicate copy of this sheet.

☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 38,235

☐ attorney or agent acting under 37 CFR 1.34(a).
Registration number if acting under 37 CFR 1.34(a): _____

K M Maschoff
Signature

Kurt M. Maschoff
Typed or printed name

203-972-0081
Telephone number

May 4, 2004
Date

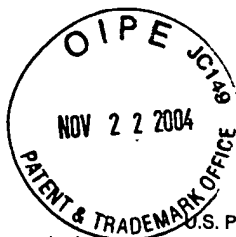
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.191. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Please type a plus sign (+) inside this box →



PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

Under the Paper Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/542,367	
	Filing Date	April 4, 2000	
	First Named Inventor	MOSKOWITZ	
	Group Art Unit	3621	
	Examiner Name	Firmin Backer	
Total Number of Pages in This Submission	2	IBM Docket Number	YOR9-2000-0171

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Notice of Appeal <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) Remarks	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Acknowledgement postcard.

COPY

RECEIVED

DEC 09 2004

GROUP 3600

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Kurt M. Maschoff
Signature	<i>K M Maschoff</i>
Date	May 4, 2004

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date:			
Type or printed name	Edith Martin	Date	May 4, 2004
Signature	<i>Edith Martin</i>	Date	May 4, 2004

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



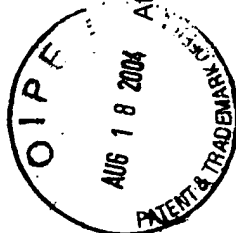
38
Date: 07/02/2004
37 C.F.R. § 1.8

Title: **SYSTEM AND METHOD FOR A FEE ADDRESS SYSTEM**

Inventor(s) Moskowitz et al.

Enclosed herewith are:

- ☒ Appeal Brief (in triplicate).
☒ Transmittal Letter.
☐



Att. Docket No.: YOR9-2000-0171
Serial No.: 09/542,367
Filing Date: 04/04/2000

101.078

RECEIVED AUG 23 2004

11

RECEIVED
NOV 24 2004
OFFICE OF PETITIONS

RECEIVED
DEC 09 2004
GROUP 3600



Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: MOSKOWITZ et al.

Application Serial No.: 09/542,367

Filing Date: April 4, 2000

For: SYSTEM AND METHOD FOR A
FEE ADDRESS SYSTEM

Group Art Unit: 3621

Examiner: Firmin Backer

Appeal Brief Transmittal

IBM Docket No. YOR9-2000-0171
(Attorney Docket No.: I01.078)

Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840
(203) 972-0006

**COPY
RECEIVED**

NOV 24 2004

OFFICE OF PETITIONS

CERTIFICATE OF MAILING UNDER 37 CFR 1.8.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 12, 2004.

Dated: Aug 12, 2004

By: Kurt M. Maschoff

Kurt M. Maschoff

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed are:

1. ☒ Appeal Brief
2. ☒ Additional Enclosures: Acknowledgement Postcard

This is a petition for a two-month extension of time for response (from June 12, 2004 to August 12, 2004, based on the date of the Final Office Action).

RECEIVED

DEC 09 2004

GROUP 3600

COPY

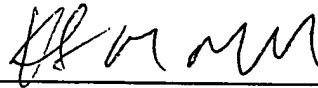
The Commissioner is hereby authorized to charge and credit Deposit Account No. 50-0510 as described below. A duplicate copy of this sheet is enclosed.

- ☒ Charge the fee of \$750.00.
- ☒ Credit any overpayment.
- ☒ Charge any additional fees required under 37 CFR 1.16 and 1.17.

Respectfully submitted,

August 12, 2004

Date



Kurt M. Maschoff
Registration No. 28,235
Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840
(203) 972-0081

RECEIVED

DEC 09 2004

GROUP 3600



Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: MOSKOWITZ et al.

Application Serial No.: 09/542,367

Filing Date: April 4, 2000

For: SYSTEM AND METHOD FOR A
FEE ADDRESS SYSTEM

)
)
) Group Art Unit: 3621

)
) Examiner: Firmin Backer

)
) **APPEAL BRIEF**

)
) IBM Docket No.: YOR9-2000-0171

)
) Attorney Docket No.: I01.078

)
) Buckley, Maschoff & Talwalkar LLC

)
) Five Elm Street

)
) New Canaan, CT 06840

)
) (203) 972-0006

COPY

RECEIVED

NOV 24 2004

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date noted below:

Dated: 9/12/04

By:

Kurt M. Maschoff

MS Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

RECEIVED

DEC 09 2004

GROUP 3600

Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed March 12, 2004 (the "Final Office Action"), rejecting claims 1, 2, 4-32 and 34-67.

COPY**REAL PARTY IN INTEREST**

The present application is assigned to INTERNATIONAL BUSINESS MACHINES CORPORATION, North Castle Drive, Armonk NY 10504, U.S.A.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellants, Appellants' legal representative, or assignee, which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1, 2, 4-32, and 34-67 are pending in the application. All pending claims stand rejected under 35 U.S.C. §103(a) as being unpatentable over Council et al. (U.S. Patent Application Publication No. 2001/0023432) (hereinafter "Council"), in view of Knepper et al. (U.S. Patent Application Publication No. 2001/0042249 (hereinafter "Knepper")).

STATUS OF AMENDMENTS

No amendments have been filed after the Final Office Action.

COPY

SUMMARY OF INVENTION

Appellants have developed systems and methods for discouraging senders from sending unwanted mail to recipients. Although techniques of some embodiments may be applied to other forms of communications, the present claims generally relate to systems that discourage senders from sending unwanted e-mail to recipients. That is, in some embodiments, Appellants have provided a system that discourages spam or other types of unwanted e-mail. (*See, e.g.*, the Specification as filed at page 2, lines 1-11).

Generally, embodiments of the present invention allow users (referred to as "recipients") to register with a central processing system to establish a "preferences record". (*Id.* at page 10, line 2 through page 11, line 5). Each recipient has both a public e-mail address and a private e-mail address. In general, a recipient only opens the e-mails received at his private e-mail address, and uses the public e-mail address as a forwarding address. The recipient provides third parties with his or her public e-mail address, and maintains the privacy of his or her private e-mail address. (*Id.* at page 5, lines 11-13).

Each recipient may establish preferences in his or her associated preferences record that specifies how messages received at the public (or "fee") e-mail address should be handled. (*Id.* at page 13, lines 10-21). Each preference record may define one or more "fee charging parameters" that specify whether certain types of e-mail received at the public e-mail address should be charged a fee for delivery to the recipient at the recipient's private e-mail address. (*Id.* at pages 8-11). For example, a preference record may specify that certain types of incoming e-mail should be assessed a flat fee for delivery to the recipient's private e-mail address. As another example, a preference record may specify that the fee will be larger for large messages, and smaller for small messages. The fee may also vary based on the priority of the message (*e.g.*, a message that is urgent, or must be opened the day received may be assessed a high fee, while a low priority message may be assessed a lower fee). (*Id.*)

The preferences record (or other account parameters) may also specify where the received fee is to be deposited or credited. For example, a recipient may provide information associated with his or her bank account and specify that any received fees be deposited in the bank account. In some embodiments, a sender is assessed a fee, which is deposited into an account associated with the system, and then the fee is credited to an account specified by the recipient. (*Id.* at page 20, line 11 through page 21, line 3). For example, the fee may be credited to the sender's bank account, or the fee may be donated to a charity or transferred to a third party. (*Id.* at page 11, lines 15-23).

A party that wishes to send an e-mail message to a recipient is only able to ensure the recipient receives (and, in some embodiments, opens) the e-mail message if the sender is willing to pay for the delivery. In this manner, embodiments "discourage the sender from bombarding recipients with excessive or very large pieces of mail." (*Id.* at page 2, lines 5-6).

ISSUES

Whether claims 1, 2, 4-32 and 34-67 are patentable under 35 USC §103 over Council et al (U.S. Patent Application Publication No. 2001/0023432, hereinafter "Council") in view of Knepper et al. (U.S. Patent Application Publication No. 2001/0042249, hereinafter "Knepper").

GROUPING OF CLAIMS

The group of claims 1, 2, 4-32, and 34-67, to which a single ground of rejection applies, do not stand or fall together as explained in the following section.

ARGUMENT

As will be explained, the rejections of each of the claims are improper because: (a) the cited combination fails to teach or suggest embodiments of the claimed invention, and/or (b) because the Examiner has improperly combined references (in particular, there is no adequate

reasoning or support for making the proposed combinations). Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

Claim 1 relates to an e-mail address system that includes means for monitoring information sent by a sender and asynchronously received at a public fee address associated with an e-mail recipient, wherein the information is unsolicited by the e-mail recipient. A fee is determined for the information, where the fee is based upon a preferences record defined by the e-mail recipient. The fee is collected from the sender into a first account, and the information is forwarded from the public fee address to a private e-mail address associated with the e-mail recipient. The collected fee is transferred to a second account. That is, two e-mail accounts are associated with the recipient, a public e-mail address and a private e-mail address. A received unsolicited e-mail is forwarded from the public e-mail address to the private e-mail address upon consultation with the recipient's preferences record and assessment of a fee if required by the preferences record.

The Council reference relates to an e-mail filtering system operated by an Internet Service Provider (ISP). When an email message is received by the ISP, the ISP compares the "source address with a list of source addresses associated with the destination address to determine whether the source address is an authorized source address. If so, the computer stores the message at the location in the ISP database corresponding to the mail box associated with the destination address, i.e., the intended recipient's mail box. If not, the computer sends an email message to the sending party in the form of an agreement or payment statement that provides the sending party with the option of paying a fee in return for the sending party's email communication to be ... [delivered to] the intended recipient." (Council at paragraph [0019]).

Put another way, Council describes an ISP system where the ISP computers can be configured to screen or filter all incoming messages and request payment for delivery of certain messages. Nothing in Council can be seen as teaching the use of both a public e-mail address and a private e-mail address, nor is there any teaching of a preferences record defined by the e-mail recipient that is used to determine a fee that is to be imposed to forward the message from the public e-mail address to the private e-mail address.

The Examiner asserts that Council teaches a system including means for monitoring information “received to a fee address associated with an email recipient”¹ and “means for forwarding the information from a public address to a private address” and refers to Council at paragraphs [0003]-[0005], [0011], [0019], [0023], [0024], [0030], and [0032]-[0033]. (Final Office Action at pages 2-3). These paragraphs of Council (and the other paragraphs of the publication) do not teach any private fee address. The address described in the Council reference is not a private address. A private address as described in the present application is an address not generally available to the public. In the Council patent, the sender has access to and addresses mail to one address: The public address of the recipient. The Council system captures the message, checks the sender's address to see if it is on an authorized list, and if it is, the message is allowed to pass to the addressed recipient's address. There is no forwarding from a public fee address to a private address because there is only a single address associated with the recipient. Contrary to the Examiner's assertion, the Council reference fails to teach or suggest the claimed use of both a public and a private e-mail address associated with a recipient. As such, the Council reference fails to teach or suggest embodiments of the present invention. As will be described further below, the Knepper reference fails to make up for this deficiency.

The Examiner agrees that the Council reference “fail[s] to teach an inventive concept with means for determining a fee for the information, wherein the fee is based upon a preference record defined by a mail recipient.” (Final Office Action at page 2). Appellants agree that this feature is not seen in the Council reference. Instead, the Council reference describes that any fees assessed are determined by the ISP, not by a preferences record defined by the e-mail recipient. As such, Council fails to teach or suggest a system having (1) both a public and a private fee address associated with a recipient, and (2) a preferences record defined by the mail recipient which determines a fee for information.

The Examiner cites the Knepper reference as “teaching an inventive concept with means for determining a fee for the information, wherein the fee is based upon a preferences record defined by a mail recipient.” (Final Office Action at page 2). The Examiner refers to Knepper at

¹ The Examiner, apparently, ignores the recitation that the fee address of claim 1 is a “public fee address associated with an e-mail recipient”.

paragraph [0041]. The Knepper reference is seen as describing a system for joining encoded video streams for continuous play, and is not seen as describing (or even relevant to) a system for forwarding emails and assessing fees. A review of the Knepper reference and the portion cited by the Examiner reveals no description of any preferences record as recited in claim 1 (e.g., where the preferences record is set up by a mail recipient to determine fees to be assessed to incoming messages).

Appellants respectfully assert that neither Council nor Knepper, alone or in any combination, teach or suggest a system having (1) both a public and a private fee address associated with a recipient, and (2) a preferences record defined by the mail recipient which determines a fee for information.

Further, even if Knepper did teach the use of such a preferences record (which Appellants assert it does not), it would not have been obvious to modify the Council reference to incorporate the record of Knepper.

To properly establish a case of obviousness over a combination of references, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The Examiner has not provided a proper motivation to modify or combine the references, nor is one available (and certainly, there is no indication of a “reasonable expectation of success” that has been provided).

Nowhere in the Council or Knepper references is any suggestion or motivation to make the combination suggested by the Examiner. As asserted by the Examiner,

it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Council et al to include Knepper’s an [sic] inventive concept with means for determining a fee for the information, wherein the fee is based upon a preferences record defined by a mail recipient because this would have ensure the proper amount be charge and paid for the email received by the intended recipient thereby enhance the efficiency of the system. (Final Office Action at page 2).

Appellants respectfully do not understand this reasoning. It appears that the Examiner believes that the combination is proper simply because the Examiner feels the “efficiency” would somehow be enhanced. How would a skilled person have concluded that the combination of a video streaming system with an email filtering system would result in a system with increased efficiency? Why would a skilled person have believed that a user-defined record is more efficient than a system defined fee record? Appellants respectfully assert that the Examiner’s reasoning is flawed and that the motivation to combine is improper.

Such general statements about the broad field of the invention fall far short of a motivation to combine these particular references in a way that would make the particular invention recited in claim 1 obvious. Similarly, the statement that “efficiency” could be “enhanced” is not “a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references” as required for a *prima facie* case of obviousness. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Further, even if the two references could potentially be combined, the resulting system would still lack elements of the claimed invention. For example, as discussed above, neither

Council nor Knepper teach or suggest the use of both a private and a public fee address associated with an email recipient. The asserted combination fails to describe a system having any or all of these features, and the Examiner has not provided any motivation to modify either of the references to provide them.

In view of the above, claim 1 is patentable under 35 U.S.C. § 103 over Council and Knepper, and Appellants respectfully request that the Examiner's rejection be reversed and/or the claims allowed. Each of the other pending claims contain limitations similar to those described above with respect to claim 1 and are patentable at least for the reasons described above. Each of the pending claims are believed patentable over the cited references, alone or in any combination.

Other claims recite additional features not taught or suggested by the cited references. For example, claims 5, 19-21, 35, and 54 recite that the fees are conditional (e.g., the user may define conditions in the preferences record that trigger different payment requirements). Claims 10, 16-17, 22-30, 40, 46-47, 59, 65-66 recite that fees are based on a size of the received email (e.g., based on the number of bits or based on a word count). Claims 8, 38, and 57 recite that the fee is based on an urgency of the message (e.g., a message having a higher urgency may be assessed a higher fee). None of these features are taught or suggested by the cited references, and the claims are patentable for at least this additional reason.

CONCLUSION

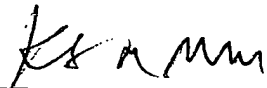
The rejections of claims 1, 2, 4-32 and 34-67 are improper at least because the Examiner has failed to cite references which teach or suggest each of the elements of the claims and further because the Examiner has improperly combined references (*i.e.*, there is no adequate reasoning or support for making the proposed combinations). Therefore, Appellants respectfully request that the Examiner's rejections be reversed and that all claims be allowed. The Final Office Action presents a number of characterizations regarding each of the applied references, some of which are not directly addressed herein because they are not related to the rejections of the

independent claims. Appellants do not necessarily agree with the characterizations and reserves the right to further discuss those characterizations.

A petition for an extension of time to respond is submitted herewith (from June 12, 2004 to August 12, 2004, as measured from the date of mailing of the Final Office Action). If any additional fees are due in conjunction with this matter, the Commissioner is hereby authorized to charge them to Deposit Account 50-0510. An Appendix of claims involved in this appeal is attached hereto.

If any issues remain, or if the Examiner or the Board has any further suggestions for expediting allowance of the present application, kindly contact the undersigned using the information provided below.

Respectfully submitted,



August 12, 2004
Date

Kurt M. Maschoff
Registration No. 38,235
Buckley, Maschoff & Talwalkar LLC
5 Elm Street
New Canaan, CT 06840
(203) 972-0081

Attachment: Appendix of claims

APPENDIX

COPY

1. An e-mail address system, comprising:
 - means for monitoring information sent by a sender and asynchronously received at a public fee address associated with an e-mail recipient, wherein the information is unsolicited by the e-mail recipient;
 - means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the e-mail recipient;
 - means for collecting the fee from the sender into a first account;
 - means for forwarding the information received at the public fee address to a private e-mail address associated with the e-mail recipient; and
 - means for transferring the collected fee to a second account.
2. The address system of claim 1, wherein the second account belongs to a third party.
4. The address system of claim 1, wherein the fees are escalating based upon number of usages.
5. The address system of claim 1, wherein the fees are conditional.
6. The address system of claim 1, wherein the fees are a combination of fixed, variable and conditional for different senders.
7. The address system of claim 1 wherein the fee is waived for a sender.
8. The address system of claim 1 wherein the fee is based upon the urgency of the information.
9. The address system of claim 1 wherein the fees are selected from the group consisting of fixed, variable or conditional.

10. The address system of claim 1 wherein the fee is based on the size of the information.
11. The address system of claim 2 wherein the third party is a charity organization.
12. The address system of claim 2 wherein the third party is a company.
13. The address system of claim 2 wherein the third party is an individual.
14. The address system of claim 2 wherein the third party is a firm.
15. The address system of claim 1 wherein the fee varies for different senders.
16. The address system of claim 10 wherein the size of the information is based on word count.
17. The address system of claim 10 wherein the size of the information is based on number of bits.
18. The address system of claim 5, wherein the e-mail recipient elects to impose a fee.
19. An e-mail address system, comprising:
 - means for monitoring information sent by a sender and asynchronously received at a public fee address associated with an e-mail recipient, wherein the information is unsolicited by the e-mail recipient;
 - means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the e-mail recipient and the fee is conditional;
 - means for collecting the fee from the sender; and
 - means for forwarding the information received at the public fee address to a private e-mail address associated with the e-mail recipient.

20. The address system of claim 19, wherein the e-mail recipient elects to impose a charge.
21. The address system of claim 19, wherein the e-mail recipient receives a portion of the collected fees.
22. A method of providing an e-mail fee address system, comprising:
 - receiving information sent by a sender at a public fee address in a computer, wherein the public fee address is associated with an e-mail recipient, and wherein the information is unsolicited by the e-mail recipient;
 - determining a fee for the information, wherein the fee is based upon a preferences record defined by the e-mail recipient and the fee increases as information size increases;
 - collecting the fee from the sender; and
 - forwarding the information from the public fee address to a private e-mail address associated with the e-mail recipient.
23. The method of claim 22, wherein the information size is measured by word count.
24. The method of claim 22, wherein the information size is measured in bits.
25. The method of claim 22 further comprising transferring the collected fees to a third party.
26. The method of claim 25 wherein the third party is a charity.
27. The method of claim 25 wherein the third party is a firm.
28. The method of claim 25 wherein the third party is an individual.
29. The method of claim 25 wherein the third party is a company.
30. The method of claim 22 wherein the information is electronic mail.

31. A programmed computer for providing an e-mail fee address system, comprising:
a memory having at least one region for storing computer executable program code; and
a processor for executing the program code stored in memory, wherein the program code includes:
- code to receive an e-mail sent by a sender to a public fee address associated with an e-mail recipient, wherein the e-mail is unsolicited by the e-mail recipient;
 - code to determine a fee for the e-mail, wherein the fee is based upon a preferences record defined by the e-mail recipient;
 - code to collect the fee from the sender into a first account;
 - code to forward the e-mail from the public fee address to a private e-mail address associated with the e-mail recipient; and
 - code to transfer the collected fee to a second account.
32. The programmed computer of claim 31 wherein the second account belongs to a third party.
34. The programmed computer of claim 31, wherein the fees are escalating based upon number of usages.
35. The programmed computer of claim 31, wherein the fees are conditional.
36. The programmed computer of claim 31, wherein the fees are a combination of fixed, variable and conditional for different senders.
37. The programmed computer of claim 31 wherein the fee is waived for a sender.
38. The programmed computer of claim 31, wherein the fee is based upon the urgency of the e-mail.
39. The programmed computer of claim 31 wherein the fees are selected from the group consisting of fixed, variable or conditional.

COPY

40. The programmed computer of claim 31, wherein the fee is based on the size of the e-mail.
41. The programmed computer of claim 32 wherein the third party is a charity organization.
42. The programmed computer of claim 32 wherein the third party is a company.
43. The programmed computer of claim 32 wherein the third party is an individual.
44. The programmed computer of claim 32 wherein the third party is a firm.
45. The programmed computer of claim 31 wherein the fee varies for different senders.
46. The programmed computer of claim 40, wherein the size of the e-mail is based on word count.
47. The programmed computer of claim 40, wherein the size of the e-mail is based on number of bits.
48. The programmed computer of claim 35, wherein the e-mail recipient elects to impose a fee.
49. Computer executable software code stored on a computer readable medium, the code for providing an e-mail fee address system, comprising:
 - code to receive a communication sent by a sender to a public fee address associated with an e-mail recipient, wherein the communication is unsolicited by the e-mail recipient;
 - code to determine a fee for the communication, wherein the fee is based upon a preferences record defined by the e-mail recipient;
 - code to collect the fee; and
 - code to forward the communication from the public fee address to a private e-mail address associated with the e-mail recipient.

COPY

50. A method of providing an e-mail fee address system, comprising:
- receiving an e-mail sent by a sender to a public fee address in a computer wherein the public fee address is associated with an e-mail recipient, and wherein the e-mail is unsolicited by the e-mail recipient;
 - determining a fee for the e-mail, wherein the fee is based upon a preferences record defined by the e-mail recipient;
 - collecting the fee from the sender into a first account;
 - forwarding the e-mail from the public fee address to a private e-mail address associated with the e-mail recipient; and
 - transferring the collected fee to a second account.
51. The method of claim 50, wherein the second account belongs to a third party.
53. The method of claim 50, wherein the fees are escalating based upon number of usages.
54. The method of claim 50, wherein the fees are conditional.
55. The method of claim 50, wherein the fees are a combination of fixed, variable and conditional for different senders.
56. The method of claim 50 wherein the fee is waived for a sender.
57. The method of claim 50, wherein the fee is based upon the urgency of the e-mail.
58. The method of claim 50 wherein the fees are selected from the group consisting of fixed, variable or conditional.
59. The method of claim 50, wherein the fee is based on the size of the e-mail.
60. The method of claim 51 wherein the third party is a charity organization.

61. The method of claim 51 wherein the third party is a company.
62. The method of claim 51 wherein the third party is an individual.
63. The method of claim 51 wherein the third party is a firm.
64. The method of claim 50 wherein the fee varies for different senders.
65. The method of claim 59, wherein the size of the e-mail is based on word count.
66. The method of claim 59, wherein the size of the e-mail is based on number of bits.
67. The method of claim 54, wherein the e-mail recipient elects to impose a fee.